

REMARKS

In the December 23, 2005 Office Action, the Examiner:

- Rejected claims 1, 3-7, 11, 15, 16, 18, 20, 21 and 26-35 under 35 U.S.C. 102(b) as being anticipated by Halvorson *et al.* (“Halvorson”, U.S. Pat. No. 4,847,764);
- Rejected claims 8-10 and 19 under 35 U.S.C. 103(a) as unpatentable over Halvorson in view of Mayaud (“Mayaud”, U.S. Pat. No. 5,845,255);
- Rejected claims 12-14 under 35 U.S.C. 103(a) as unpatentable over Halvorson in view of *nevoca.com Enhances Prescription Verification System* (“nevoca”); and
- Rejected claims 17 and 22-25 under 35 U.S.C. 103(a) as unpatentable over Halvorson in view of *Biomerica and Viking Components Announce Strategic Partnership for Final Phase of ReadyScript* (“ReadyScript”).

Applicants retain the claims in their current form and respectfully presents arguments for their allowability. Should Applicants arguments not convince the Examiner that the claims are now in condition for allowance, Applicants requests an interview with the Examiner and his supervisor as soon as possible.

Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 1, 3-7, 11, 15, 16, 18, 20, 21 and 26-35 under 35 U.S.C. 102(b) as being anticipated by Halvorson. Halvorson relates to a computer dispensing system for health care institutions. This dispensing system controls the dispensing of medication orders, *i.e.*, medication dispensing data, that are entered into the dispensing system by pharmacists. See Abstract and Summary.

The present invention, however, relates to renewal prescriptions. Renewal prescriptions are a term of art that are defined on page 3 of the present application as “a new prescription based at least in part upon the original prescription, *i.e.* for a pharmaceutical drug in the same therapeutic category (often the identical pharmaceutical drug), requiring a new authorization from the physician.” As will be shown below, the “renewal prescription” of the present claims cannot be interpreted to include the “order” entered into the dispensing system of Halvorson.

Halvorson only mentions prescriptions in the claims and cursorily in the background of the application. Rather, *Halvorson* discloses orders that are entered and dispensed by a health care institution's pharmacy or dispensary, and not the prescriptions that may have led to these dispensing orders in the first place.¹

Moreover, *Halvorson* distinguishes orders from prescriptions. For example, claim 22 of *Halvorson* states that the dispensing system holds “medication order data specifying medication orders for patients in said institution in accordance with medication prescriptions for said patients . . .” In other words, while the order is based on a prescription, it is not the prescription itself. As such, electronically requesting and obtaining a renewal prescription, as required by the pending claims, cannot be interpreted to cover an order that is renewed in the dispensing system by a pharmacist.

Further, not only does *Halvorson* fail to teach prescriptions, but it also does not disclose, teach, or suggest renewal prescriptions. The only mention of the terms “renew” or “renewal” in *Halvorson* relates to orders and not prescriptions. Preauthorization of an order before it is renewed in the dispensing system of *Halvorson* cannot be likened to electronically obtaining a renewal prescription from a prescriber.

Still further, independent claims 1 and 31 include the limitation of “computer generating a prescription renewal request for the renewal of said prescription . . .” As support for this limitation, the Examiner cites to the following portion of *Halvorson*:

A report will be produced at each dispensing location that informs each physician of all of the orders that will be discontinued within the next 24 hours, if the orders are not renewed.

(emphasis added). *See* col. 5, lines 29-32. This report is nothing more than a summary of information, and does not request the prescriber to do anything with the information. In other words, the report cannot be said to be a prescription renewal request, in which the prescriber is requested to renew a prescription. What, if anything, a physician does with the information presented in the report is at best unclear from the teaching of *Halvorson*. As such, *Halvorson* does not disclose, teach, or suggest the limitation of generating a prescription renewal request.

Moreover, per the preamble, all of the steps of independent claims 1 and 31, including the “transmitting” and “receiving” steps are performed “via an electronic network.” Simply printing out a report that a physician may or may not receive or review, cannot be considered

¹ The dispensing process occurs after the dispenser is notified to fill the renewal prescription, *i.e.*, after the final step in claims 1 and 31.

to be “transmitting” the prescription renewal request to a prescriber via an electronic network. Similarly, receiving an authorization from a physician to renew an order, cannot be considered to be “receiving” a renewal prescription via an electronic network. Therefore, for this reason alone, independent claims 1 and 31 cannot be anticipated by *Halvorson*, as *Halvorson* does not teach transmitting a prescription renewal request, or receiving a renewal prescription via an electronic network.

Furthermore, claims 1 and 31 include the limitation of “receiving a renewal prescription, in response to said renewal request, from said prescriber.” As support for this limitation, the Examiner relies on the following portion of *Halvorson*:

The preferred dispensing station will have a dispenser 32 which contains a plurality of medications that may be automatically dispensed to authorized personnel on demand. No medications are dispensed without first being authorized by a physician.

See (col. 4, lines 28-32). This citation merely discloses that orders entered into the dispensing system are gated by physician authorization. It does not, however, disclose, teach, or suggest that a renewal prescription (a well known term of art) is received in response to a prescription renewal request. For this reason alone, independent claims 1 and 31 cannot be anticipated by *Halvorson*.

Preceding on the assumption that the Examiner may argue that these limitations are inherent to the teachings of *Halvorson*, Applicants note the discussion of inherency in MPEP 2112.IV, which states that “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” (emphasis added.) As such, any potential inherency rejections should be carefully considered before being made by the Examiner.

Since *Halvorson* does not disclose, teach, or suggest the majority of the limitations of claims 1 and 31, *Halvorson* cannot anticipate these claims. And since dependent claims 3-7, 11, 15, 16, 18, 20, 21, 26-30, and 32-35 include the limitations of their parent claims, *Halvorson* does not anticipate any of these claims either. Accordingly, the Examiner is respectfully requested to withdraw these anticipation rejections.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected (i) claims 8-10 and 19, (ii) claims 12-14, (iii) claims 17 and 22-25, (iv) claim 22, (v) claim 24, and (vi) claim 25 under 35 U.S.C. 103(a) as unpatentable over *Halvorson* in view of a number of different references. These claims all depend on claim 1, and, therefore, include all of the limitations of claim 1. As discussed above, *Halvorson* does not teach or suggest the majority of the limitations of claim 1. Therefore, the cited combination of *Halvorson* in view of other secondary references also does not teach or suggest all the limitations of these claims. Since dependent claims include the limitations of their parent claim, the cited combination does not teach or suggest the limitations of these claims either. As such, the cited combination is not *prima facie* obvious, and withdrawal of these rejections is respectfully requested.

Prior Art Made of Record

The Examiner cites additional references upon which he has not relied: Brinkman (2005/0065818), an article in Drug Store News, a Business Wire Article about Alteer Corp., and an article by Parks in Drug Store News. Under 37 CFR 1.111(b), "(t)he reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references" (emphasis added). It is respectfully noted that the office action did not apply any of these listed references to any of the pending claims. Nevertheless, Applicants observe that none of these cited references teaches alone or in combination all the limitations of the pending claims.


CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, Applicants request an interview with the Examiner and his supervisor as soon as possible. The undersigned attorney can be contacted at 650-843-7519 to set up the interview.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 61018-0008-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

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Dion M. Bregman 45,645
(Reg. No.)
MORGAN, LEWIS & BOCKIUS LLP
2 Palo Alto Square
3000 El Camino Real, Suite 700
Palo Alto, California 94306
(650) 843-4000